

Remarks

This Amendment is in response to the Office Action dated **July 21, 2011**. Claims 1-33 are pending in this application. The Office Action rejected claims 1-33 under 35 USC § 251 as being an improper recapture of subject matter that was surrendered during prosecution of US 6019789.

The rejection is traversed because there was no surrender of subject matter during the prosecution of US 6019789 – therefore, there is no problem of recapture.

Additionally, claims 1-15 have been clarified in this reissue application but not necessarily broadened. Limitations removed from these claims were replaced with clarified language that was deemed more accurate. Claims 16-33 were newly added in the reissue application, and are directed to “overlooked aspects” of the invention. Therefore, even if prosecution of US 6019789 had included a surrender of subject matter, none of the pending claims would violate the Rule Against Recapture because the claims have been materially narrowed in other respects.

Amendments - Claims and Specification

This Amendment indicates amendments to the claims and specification vis-à-vis the original patent, and is believed to be in full compliance with 37 CFR § 1.173. This Amendment does not present any new amendments to the claims or specification – the amendments have been carried over from the last Amendment, filed October 6, 2009.

Status of Claims

As of the date of this Amendment, patent claims 1-15 are all pending, and added claims 16-33 are all pending. Claims 34-37 were previously cancelled.

Recapture

As noted by the Examiner, MPEP § 1412.02 provides a three step procedure for determining whether claims should be rejected as recapturing canceled subject matter.

The first step is to determine whether there was broadening.¹ The Examiner has concluded that because certain limitations were deleted from claims 1 and 5, and because the other independent claims added to the reissue application did not include those limitations, all of the claims have been broadened.²

Applicants do not necessarily concede that all of the claims have been broadened; however, since this reissue application was intended to be a broadening reissue, Applicants do not traverse the Examiner's conclusion with respect to the first step.³

The second step is to determine whether a broadening aspect of the reissue claim relates to surrendered subject matter. This second step includes two sub-steps: A) determine if there was a surrender of subject matter; and B) if there was a surrender of subject matter, the Examiner must analyze the claims to determine whether the broadening of reissue claims is in the area of the surrendered subject matter.⁴

The Examiner concluded that arguments made during the prosecution of US 6019789 amounted to a surrender of subject matter, and that the reissue claims recaptured the surrendered subject matter – the Office Action states the following at page 4:

NOTE: the Examiner wants to point out that all the independent claims are broader than the original claims, therefore, they are all improperly recaptured.

Applicants traverse the Examiner's conclusions with respect to both sub-steps of the second step. Applicants contend that the remarks made during prosecution of US 6019789 did not amount to any surrender of subject matter. Therefore, the Examiner's conclusion is improper. Further, the Examiner appears to ignore the third step of the three step procedure, which is discussed below.

Arguments Made in US 6019789

The Examiner contends that arguments made during prosecution of US 6019789 "make the case allowable, therefore, that language must stay in the claims in order to avoid

¹ See MPEP § 1412.02(I).

² See Office Action at page 3.

³ Applicants reserve the right to traverse the Examiner's conclusion with respect to the first step.

⁴ See MPEP § 1412.02(I).

recapture.”⁵

To the contrary, the remarks made during prosecution of the underlying patent merely addressed reasons that the USPTO failed to present any *prima facie* case of anticipation or obviousness against the rejected claims. The remarks did nothing to surrender any claim scope.

Applicants did not make any claim amendments during prosecution of the patent claims. It is unclear how Applicants remarks, which merely asserted that the USPTO had not met its burden in making rejections, limited the claims in any way.

The text of 35 USC § 251 does not provide for the Rule Against Recapture. Thus, the Rule appears to be judicially created, and based upon principles of estoppel. A patentee may not “regain[] through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims.” *In re Clement*, 131 F.3d 1464, 1468 (Fed. Cir. 1997).

Of the judicial cases cited by the Examiner in support of the Recapture rejection, *Hester Industries v Stein*, 46 USPQ2d 1161 (Fed. Cir. 1998), appears to be the only case where a surrender of subject matter was found based from argument alone. The facts of that case are quite distinguishable from the facts of this reissue application.

In *Hester*, the applicant repeatedly asserted that the limitations at issue distinguished the claims from the prior art, and were critical with regard to patentability. The court found that the patent applicant’s repeated arguments amounted to an admission that the limitations were necessary to overcome the prior art.

The following text is recreated from *Hester*:

At no less than 27 places in six papers submitted to the Patent Office, Williams asserted that the “solely with steam” limitation distinguished the claimed invention from the prior art, and Williams did the same with respect to the “two sources of steam” limitation at no less than 15 places in at least five papers. Williams argued that each of these limitations was “critical” with regard to patentability, and Williams further stated that the “solely with steam” limitation was “very material” in this regard. In essence, these repeated arguments constitute an admission by Williams that these limitations were necessary to overcome the prior art. Indeed, when the Board reversed the Examiner’s rejection of the original claims, these were the primary bases indicated for patentability. Williams, through his admission effected by way of his repeated prosecution arguments, surrendered claim scope that does not include these limitations.

In the current case, Applicants made no such admission as to any claim limitation.

⁵ See Office Action at page 4.

The Office Action mailed 3/18/99 rejected claims 1-14 as being anticipated under 35 USC § 102 by each of Al-Saadon, Klein, Lau and Orth, and rejected claim 15 as being obvious under 35 USC § 103 over Al-Saadon in view of Phan.

In the Amendment filed 6/4/99, Applicants traversed all of the asserted rejections. With respect to each of the rejections under 35 USC § 102, Applicants directed the Examiner's attention to limitations from the original claims that the cited reference failed to teach. With respect to the rejection under 35 USC § 103, Applicants asserted that the combination of Al-Saadon and Phan failed to teach each limitation of the rejected claim due to the limitation missing from Al-Saadon, which was discussed with respect to the anticipation rejection. In response to these arguments, the rejections were withdrawn and the claims were allowed as originally filed.

Nothing in Applicants' remarks amounted to an admission that any limitation was critical to patentability, or specifically relied upon to distinguish the claims from the prior art.

Nothing in Applicants' remarks created estoppel by clarifying the meaning of any claim limitation – i.e. the examiner's understanding of given limitation was not changed by Applicants' remarks, and the remarks did not "make the claims allowable" by providing a narrower definition of a claim term in order to overcome a valid prior art rejection. There was no surrender of subject matter.

The reissue Examiner asserts that several limitations were made critical by Applicants' remarks, and those limitations must not be deleted. The specific terms, included in the Office Action at page 4, are shown below.

not have. For example, page 5 discloses that the prior art does not show: "a central connecting beam (connecting bar) with a pair of arms on either end, the arms joined by a looped member"; "connecting bar having a pair of arms at each end"; "arms pivoting outwardly from the connecting bar"; "arms and expandable looped members are constructed and dimensioned so that the radial outward distance traveled by arms outer ends... is approximately equal to the axial inward distance traveled by the ...looped member extremity, as the stent is expanded."; and "an

expandable looped member which joins arm pairs at each end of a connecting bar". In order to avoid recapture rule, the Applicant's representative must keep each and every word that was argued in the Applicant's remarks.

Thus, the Examiner asserts that all of the limitations mentioned above are critical, and deletion of any of these terms amounts to an improper recapture. This assertion is traversed.

The Examiner's position that Applicants "must keep each and every word that was argued" during prosecution of the original application in the reissue claims to avoid recapture is problematic. The Examiner has not cited to any authority that supports the assertion. In asserting that removal of any of the limitations mentioned above would amount to an impermissible recapture, the Examiner essentially asserts that Applicants' prior remarks surrendered all subject matter that does not include a "connecting bar having a pair of arms at each end," surrendered all subject matter that does not include "arms pivoting outwardly from the connecting bar," surrendered all subject matter that does not include "arms and expandable looped members...", etc.

An argument that merely states that all the limitations of the claims define over the prior art will not, by itself, be sufficient to establish surrender and recapture.⁶

None of the claim limitations mentioned above were established as being critical during prosecution of the original patent. The claim limitations were each mentioned while asserting that the USPTO failed to present a *prima facie* case of anticipation. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.⁷ In traversing an anticipation rejection, a patent applicant need only show that a single claim limitation is missing from the prior art reference at issue. If the prior art reference fails to teach multiple claim limitations, and a patent applicant argues that the reference fails to anticipate for multiple reasons, those multiple limitations missing from the reference do not each become critical to the patent applicant's invention.

In this case, Applicants' remarks during prosecution of the original patent do not

⁶ MPEP § 1412.02(I)(B)(2)

⁷ See MPEP §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

establish that each mentioned limitation is critical to the invention – conversely, the remarks are evidence that the USPTO issued several improper rejections. The remarks simply amount to a restatement of claim limitations that were originally filed, which were ultimately allowed in the original patent. No estoppel was created by these remarks – the remarks did not change the Examiner’s understanding of a particular claim limitation or “make the claims allowable” by providing a narrower definition of a claim term in order to overcome a valid prior art rejection.

No measure of surrendered subject matter can be gleaned from the remarks at issue.

“The recapture rule is triggered only where the reissue claims are broader than the patented claims because the surrendered subject matter has been re-claimed in whole or substantial part (i.e., an added limitation has been eliminated or revised).”⁸

There was no surrender of subject matter during prosecution of the original patent. Because no subject matter was surrendered, there can be no impermissible recapture of such subject matter.

Applicants request withdrawal of the Improper Recapture rejections asserted against claims 1-33.

Third Step

The third step of the impermissible recapture analysis is to determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule.⁹ In this final step, the court [Examiner] must “determine whether the surrendered subject matter has crept into the reissue claim.”¹⁰

Although Applicants’ primary position is that no subject matter was surrendered during prosecution of the original patent, in the alternative, Applicants’ assert that if the remarks made during the original prosecution are determined to have included a surrender of claim scope, then the current reissue claims have been materially narrowed in other respects and avoid the Rule Against Recapture.

⁸ *In re Mostafazadeh* (Fed. Cir. 2011). Available at <http://www.cafc.uscourts.gov/images/stories/opinions-orders/10-1260.pdf>

⁹ MPEP 1412.02

¹⁰ *In re Mostafazadeh* (Fed. Cir. 2011), citing *In re Clement*, 131 F.3d 1464, 1469 (Fed. Cir. 1997)

The currently pending claims in this reissue application can be divided into two groups – the original patent claims 1-15, and added claims 16-33.

Claims 1-15

Independent claims 1 and 5 have each been amended in this reissue application, in order to clarify the claim language to be more accurate. For each limitation that was removed, a similar and more appropriate limitation has been substituted in its place.

For example, independent claim 1 deletes the phrase “extremity which moves axially inwardly, with respect to the associated connecting bar end,” but adds the phrase, “component length as measured in an axial direction from an axial outward extremity to an axial inward extremity, wherein the axial component length reduces.” Additionally, a “radial outward distance” has been deleted in favor of the term “axial outward distance,” which is more accurate.

Claims 1 and 5 as clarified in this reissue application are very similar in scope to the original patent claims. The Examiner has not specifically identified any subject matter that has been removed from claims 1 or 5. Therefore, the Examiner has not met the initial burden required to reject either claim 1 or 5 under the theory of an impermissible recapture.

Further, for any limitation removed from claims 1 or 5, more appropriate limitations have been added back to the claim. Therefore, even if the removal of a limitation would have amounted to a recapture, the limitations added to claims 1 and 5 result in a material narrowing of the claim such that recapture is not an issue.

Therefore, Applicants request withdrawal of the Impermissible Recapture rejections asserted against claims 1-15.

Claims 16-33

Claims 16-33 have been added to the reissue application in order to claim overlooked aspects of the invention.

Please note that original patent claims 1-15 recite a “unit cell,” and do not include terms such as “serpentine band.” A person of ordinary skill in the art will recognize that stents are often claimed using “serpentine band” language. During prosecution of the original patent, an aspect of describing and claiming the invention as an assembly of “serpentine bands” was

overlooked.

With respect to added claims 16-33, Applicant requests that the alleged surrendered subject matter be identified explicitly. Although these claims may not include the specific limitations mentioned by the Examiner, they are intended to claim the stent in different ways. The additional limitations materially narrow the claims such that an impermissible recapture is avoided.

A limitation “materially narrows” the reissue claims if the narrowing limitation is directed to one or more “overlooked aspects” of the invention. *Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 1482-83 (Fed. Cir. 1998).

Claims 16-33 describe the claimed stent using limitations that were not included in the original patent claims. These claims are directed to overlooked aspects of the invention, and the scope of these claims is not related to any subject matter that the Examiner alleges was surrendered during the original prosecution. Therefore, claims 16-33 do not present any problem of recapture.

Applicants request withdrawal of the Improper Recapture rejections asserted against claims 16-33.

Request for Explanation

If any of the Impermissible Recapture rejections are maintained, Applicants request that the statement of the rejection explicitly identify the subject matter that was allegedly surrendered during prosecution of the original application.

Merely asserting that certain limitations from the original patent claims cannot be removed from the reissue claims does not identify the subject matter that was allegedly surrendered. Without a clear identification of the surrendered subject matter, it is not possible to “determine whether the surrendered subject matter has crept into the reissue claim.”¹¹

¹¹ *In re Mostafazadeh* (Fed. Cir. 2011)

Conclusion

Based on at least the foregoing amendments and remarks, Applicants respectfully submit the pending claims are patentable over the applied references. Favorable consideration and prompt allowance of claims 1-33 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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